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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			SUHOL, DMITRY	
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			3714	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/028,335	Applicant(s) STAMM ET AL.	
	Examiner Dmitry Suhol	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 August 2004.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 and 16-23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 and 16-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Objections

Claim 23 is objected to because of the following informalities:

Regarding claim 23, the phrase "including items in each of a plurality of databases" should be clarified. A database is a collection of information stored in an organized manner on a computer media it can not contain items of any physical nature, according to applicants disclosure in paragraph 0020 a database contains images of activity items rather than actual items. For clarity purposes applicants should clarify that the database hold images of items in the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, there is no support in the original specification or drawings of a housing including at least one different item related to each area of brain development

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as required by claim 1. Although the specification makes it clear that one or more items may be included in the housing, there is no disclosure of a housing including at least one different item related to each area of brain development.

Regarding claim 23, there is no support in the disclosure of "a plurality of databases" in fact in paragraph 0020 the disclosure clearly teaches a single database and not a plurality thereof.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, there is no antecedent basis for "at least one of said items" appearing in the fifth line of the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Brilliant! Beginnings™ Baby Brain Basics™ Birth to 12 months Parent Kit", here

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from referred to as Brilliant beginnings in view of Werzberger '298. Brilliant beginnings discloses a system and method for facilitating early brain development containing most of the elements of the claims including, obtaining a system for facilitating early brain development (read onto obtaining the brilliant beginnings system) wherein the system targets a predetermined stage of development (pages 79-80 in guide book) as required by claims 1 and 16, including at least one different item in a housing specifically related to each area of brain development (security, touch, eyes, play and sound) is shown as the "Baby's Rhyming Photo Book" and CD's where the two are clearly related to each area of brain development (i.e. a photo book is related to security since pictures of family members may be placed therein, to touch since it can clearly be touched, to eyes since it can be seen, to play since it can be played with and to sound since the material it is made of produces a sound when manipulated), selecting an activity card (located within the housing) wherein the activity card describes at least one activity that stimulates a predetermined aspect of brain development (read onto the selection of the appropriate page of activities described on pages 84 [specifically, the activity entitled faces is an activity that may be practiced with the item "Baby's Rhyming Photo Book" found in the housing], 88-90, 94-97, 103-108, 114-118) as required by claims 1, 4 and 16. The step of engaging a child's attention, as required by claims 1, 7 and 16, is described through out pages 84, 88-90, 94-97, 103-108, 114-118. An example of a step of modeling a selected activity for a child and prompting the child to perform the selected activity, as required by claims 1, 12 and 16, is described on page 115 under the activity entitled "Let's Go Bowling". It should be pointed out that although the dolls

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described in the activity are not explicitly provided in the housing the system of Brilliant beginnings does provide the caregiver with a booklet of appropriate toys (e.g. "Toy Guide") including dolls and soft balls as required by the activity "Let's go bowling". Therefore it would have been obvious to provide the dolls and balls with the system of Brilliant Beginnings for the purpose of providing a complete system to the caregiver and child.

Obtaining stage specific activity cards comprising caregiver directions, as required by claims 2 and 16, is described on pages 79-80 and the different activities and caregiver instructions are shown in pages 84, 88-90, 94-97, 103-108 and 114-118. Obtaining a first item to stimulate vision, as required by claims 2 and 5, is described on page 84 under the heading "Faces" where an item (picture) is obtained and used to stimulate a baby's visual acuity. Obtaining a second item whose use promotes the concept of attention, as required by claims 3 and 6, is described on page 84 under the heading "Changeable Mobile" where there are a plurality of objects obtained and used to promote attention from a baby. Brilliant beginnings further discloses the importance of facial contact with a baby/child and directing the child attention to a defined space (page 84, activities entitled "Faces", "Funny Faces", and "Changeable Mobile", where the location of the mobile of the pictures is considered to be a defined space), as well as explicitly teaching a step of engagement being comprised of focusing a child's attention on an activity by establishing eye contact with the child (page 103, activity entitled "Pop the Balloon").

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Regarding claim 8, encouraging a child through a visual stimulus is described on page 84, activities entitled “Faces”, “Funny Faces”, “Changeable Mobile”.

Regarding claim 9, visual stimulus comprising at least one of varied facial expressions and use of an object is described on page 84, activities entitled “Faces” and “Funny Faces”.

Regarding claim 10, the use of a sound-generating object to engage a child is described on page 95, activity entitled “Bells and Things” and page 103, activity entitled “Jingle the Bell”.

Regarding claim 11, varied voice intonations are described throughout the guide book including on pages 84, activity entitled “The Magic Breadth”, page 90, activity entitled “Sing Songs” and “Read, Read, Read” and especially on page 96, activity entitled “Leg over Leg”.

Regarding claims 16 and 21-22, a description of at least one importance of the selected activity is found in the benefits section related to each activity as described throughout the handbook, while similar activities that can also be accomplished to work on the same skill are shown (for example) on page 84 under “activities to nurture intellectual development”.

Regarding claims 1, 16 and 22, a description of at least one importance of the selected activity to brain building of future school skills is found throughout the handbook (for example, activity listed on page 117 entitled “What’s This?” is clearly teaching comprehension of words [a must in school]).

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Although Brilliant Beginnings does not appear to explicitly contain indicia that provides background information about the type of activity and suggestions about what to say to the child, as required by claims 16 and 22, it would have been obvious to have provided such information since it would only depend on desired information to be displayed. Furthermore, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of description/information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

The use of different manners of providing instructions, as required by claim 13, is pointed to through out the guidebook. For example, on page 115 all of the activities require instructions and the step of demonstrating the activity as described would read upon the use of minimal verbal cues.

Although Brilliant beginnings discloses most of the elements of the claims the reference utilizes a guide book and not "activity cards" as claimed by claims 1-2. However Werzberger '298 teaches that it is known to provide activities listed on activity cards to educate and instruct (figure 9, element 416). Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to print

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the activities of Brilliant beginnings upon activity cards instead of in a guide book for the purpose of providing a easily manipulated activity instruction.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen '658 in view of Brilliant beginnings. Brilliant beginnings teaches that it is known to provide an educational system which is related to a predetermined stage focusing on specific areas of brain development such as security, touch, eyes, play and sound, as stated above, however the reference fails to teach a system being electronic by utilizing databases to produce images of activities on the screen, as required by claim 23.

However, Cohen discloses an electronic based educational system which teaches that it is known to provide a system simulating activities in an electronic form (see last line of the abstract and figures 5a-5i and 6a-6i) through the use of databases (col. 3, lines 46-50). Therefore it would have been obvious to provide a system of Brilliant beginnings as an electronic version for the purpose of introducing infants and young children to computers.

Response to Arguments

Applicant's arguments filed 8/23/2004 have been fully considered but they are not persuasive. Applicants argue that Brilliant Beginnings fails to disclose/teach a brain link and school link as claimed by the limitation of an "...activity card further describes at least one importance of said selected activity to brain building of future school skills...". In response the examiner points out that the function of Brilliant Beginnings is clearly to

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increase/assist a child's brain development which is clearly tied to future school skills, as stated above. Furthermore, the examiner reminds that applicants that it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include activity cards which describe at least one importance of a selected activity to brain building of future school skills since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information regarding the product and its use and benefit does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. description of at least one importance of selected activities to brain building of future school skills) and the substrate (e.g. activity cards) which is required for patentability.

Applicants appear to further argue the concept of commercial success. In response the examiner points out that

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:
In the *ex parte* process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. C.f. *Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting

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burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success. In re Huang , 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also In re GPAC, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness). The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973).

In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient. Ex parte Remark, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990). Compare Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988) (In civil litigation, a patentee does not have to prove that the commercial success is not due to other factors. "A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence."). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product); In re Fielder, 471 F.2d 690, 176 USPQ 300 (CCPA 1973) (success of invention could be due to recent changes in related technology or consumer demand; here success of claimed voting ballot could be due to the contemporary drive toward greater use of automated data processing techniques); EWP Corp. v. Reliance Universal, Inc., 755 F.2d 898, 225 USPQ 20 (Fed. Cir. 1985) (evidence of licensing is a secondary consideration which must be carefully appraised as to its evidentiary value

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because licensing programs may succeed for reasons unrelated to the unobviousness of the product or process, e.g., license is mutually beneficial or less expensive than defending infringement suits); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986) (Evidence of commercial success supported a conclusion of nonobviousness of claims to an immunometric "sandwich" assay with monoclonal antibodies. Patentee's assays became a market leader with 25% of the market within a few years. Evidence of advertising did not show absence of a nexus between commercial success and the merits of the claimed invention because spending 25-35% of sales on marketing was not inordinate (mature companies spent 17-32% of sales in this market), and advertising served primarily to make industry aware of the product because this is not kind of merchandise that can be sold by advertising hyperbole.).

In this case applicants have not provided any type of nexus between their claimed product and its purported commercial success. There is no evidence provided that the sales of applicant's product have out performed the sales of Brilliant Beginnings or that the claimed features as recited by the applicants are the reasons for the success or the amount of money spent on advertising vs. products of a similar nature or any other evidence which would be needed in order to consider commercial success for patentability. Furthermore, the quotes provided by the applicants from a variety of "business leaders" are not in affidavit form and therefore hold little weight.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

Dmitry Suhov
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